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10/706,630	11/12/2003	Marguerite B. McDonald	55915-79433	7979

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W. EDWARD RAMAGE
COMMERCE CENTER SUITE 1000
211 COMMERCE ST
NASHVILLE, TN 37201

EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/706,630	Applicant(s) MCDONALD, MARGUERITE B.	
	Examiner Paul B. Prebilic	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 37-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 and 37-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The indicated allowability of claims 3, 4, and 12-38 is withdrawn in view of the newly discovered reference(s) to Cumming and Cohen. Rejections based on the newly cited reference(s) follow.

Claim Objections

Claims 1, 5, 12, and 39 are objected to because of the following informalities:

Regarding claim 1, lines 10-11, "the eye" lacks antecedent basis.

Regarding claim 10, line 10, claim 12, lines 16-17, and claim 39, line 12, the claim language appears to be directed to a use of the device instead of a device. For this reason, the Examiner suggests changing "encompasses" to ---sized to encompass-- in order to overcome this objection.

Regarding claim 5, the term "comprises" is confusing in view of the fact that previous elements of the lens body have been set forth. For this reason, the Examiner suggests changing "comprises" to ---is formed of--- in order to overcome this objection.

Regarding claims 12 and 39, the preambles are confusing in view of the fact that "multifocal intraocular lens" is used therein, but the body of the claim sets forth a "lens body" that is not clearly related thereto and is not necessarily multifocal. Furthermore, the body of the claim does not clearly require the preamble for completeness so it is unclear how limiting "multifocal intraocular lens" is.

Regarding claim 39, line 1, "systems" is not clear because it is plural, and does not match the adjective "A." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 38 does not have a claim number from which it depends, and thus, it has an indefinite scope. Since the scope of the claim cannot be determined, it will not be evaluated on its merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5, 6, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Mandell et al (US 6,871,953). Mandell anticipates the claim language where the claim preambles are not required in the body of the claim and Figure 1 shows a semicircular cross-section where the cross-section is taken along the optical axis of the lens. The shape is considered to be in the shape of a comma because commas can be written in many ways, and for this reason, this limitation is interpreted broadly as merely requiring a curved surface.

Claims 1, 2, and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Portney (US 4,898,461). Portney anticipates the claim language where the periphery thereof is outside peaks (54) and (56) (see Figures 4 and 8A), the anterior and posterior surfaces are "substantially elliptical" because "substantially" is a broad term, and the periphery is tapered from the peaks (54, 56) to the edges such that the claim language is read upon by Portney; see the abstract. The lower portion as claimed is the lower half of Portney's lens since the cross-section can be taken perpendicular to the optical axis.

With regard to claim 7, Applicant is directed to see column 6, lines 41-65 and column 7, lines 11-35.

With regard to claim 8, the Examiner asserts that at least one of the zones on the lower half of the lens inherently has a greater index than one of the zones on the upper half of the lens such that the claim language is fully met. This is due to the fact that the same base material is used and the lens is altered to have greater indices in some zones as compared to others.

Claims 1, 5-9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Gupta et al (US 5,728, 156). Gupta meets the claim language where the lower portion with semicircular shape as claimed is shown in Figure 4 below the center spot (i.e. the lower half of the lens), the substantially elliptical posterior and anterior portions are shown in Figure 5 where the outer edge of Figure 5 is taken to be the same as that shown in Figure 4.

With regard to claims 7 and 8, Applicant is directed to column 6, line 40 to column 8, line 30 where the wedge gives the lower portion a greater index of refraction.

Claims 12-16, 18, 21, 22, 26, 30/12, 32, 33 and 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Cumming (US 5,562,731). Cumming anticipates the claim language where the lens capsule is clearly inflated with a liquid that would allow the lens to move therein; see Figures 41, 41A, and 42 as well as column 18, line 15 to column 19, line 20, column 13, lines 51-57 and column 2, lines 22-30.

With regard to claims 14 and 15, the language of these claims is interpreted broadly such that any device that is capable of being used as such would meet the claim language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al (US 5,728,156) in view of Grendahl (US 4,778,462). Gupta meets the claim language as explained *supra*, but fails to disclose a colored or "not colorless" lens as claimed. However, Grendahl teaches that it was known to color different parts of intraocular lenses with different colors for enhanced accommodation; see column 2, lines 15-19. Therefore, it is the Examiner's position that it would have been obvious to color the different portions of the Gupta lens system for the same reason that Grendahl does the same.

Claims 17, 34, 35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cumming (US 5,562,731) in view of Lin et al (US 6,533,813).

Regarding claim 17, Cumming meets the claim language but fails to disclose the capsule relative proportions as claimed. However, Lin teaches that such capsule proportions were known to the art; see the figures. Therefore, it is the Examiner's position that it would have been obvious to make the capsule of Cumming in the shape of Lin so as to fit a person with a narrower capsule cavity.

Regarding claims 34, 35, and 37, Cumming meets the claim language except for the means for holding the capsule in the eye. However, Lin teaches that such features were known to the art; see Figures 5 and 7. Therefore, it is the Examiner's position that it would have been obvious to include means for holding the capsule in place on the Cumming capsule for the same reasons that Lin uses the same and to more securely hold the device in place within the eye.

Claims 23-25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cumming (US 5,562,731) in view of Cohen (US 5,117,306). Cumming meets the claim language except fails to disclose the use of various radii of curvature, varied curvatures, or aspherical features. However, Cohen teaches that it was known to have such features on similar lenses within the art; see Figure 4. Since Cumming is usable with a variety of lenses, the Examiner asserts that it would have been obvious utilize the lens of Cohen in the Cumming device for the same reasons that Cohen uses the same.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cumming (US 5,562,731) in view of Saishin et al (US 2001/0049532). Cumming meets

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the claim language but fails to disclose the material used to make the lens capsule as claimed. However, Saishin (see paragraph 169) teaches that it was known to make similar lens capsules out of silicone. Therefore, it is the Examiner's position that it would have been obvious to make the lens capsule of Cumming out of silicone for the same reasons that Saishin uses the same and because silicone is a well tolerated pliable material.

Claims 19, 31, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cumming (US 5,562,731) in view of Abraham (US 3,809,092). Cumming meets the claim language except for the colored or "not colorless" material of the lens capsule or substance as claimed. However, Abraham teaches that it was known to coat lens capsules and other eye portion with a coloring material in order to detect them during surgery; see the abstract. Therefore, it is the Examiner's position that it would have been obvious to coat the artificial capsule or the substance with coloring material in order to detect their presence and location during surgery and thereafter.

Claims 29, and 30/29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cumming (US 5,562,731) in view of Grendahl (US 4,778,462). Cumming meets the claim language as explained *supra*, but fails to disclose a colored or "not colorless" lens as claimed. However, Grendahl teaches that it was known to color different parts of intraocular lenses with different colors for enhanced accommodation; see column 2, lines 15-19. Therefore, it is the Examiner's position that it would have been obvious to

color the different portions of the Cumming lens system for the same reason that Grendahl does the same.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cumming (US 5,562,731) in view of Gupta (US 5,728,156). Cumming meets the claim language as explained in the Section 102 rejection, but fails to teach using a lens where different portions of the lens have different refractive indices. However, Gupta teaches that it was known to the art to make lens with variable refractive indices; see the previously cited portions. Therefore, it is the Examiner's position that it would have been obvious to utilize a lens with variable indices of refraction for the same reasons that Gupta uses the same.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta (US 5,728,156) in view of Cohen (US 5,117,306). Gupta meets the claim language as explained in the Section 102 rejection supra, but fails to disclose the use of multiple radii of curvature. However, Cohen teaches that it was known to utilize such features on similar lenses within the art; see Figure 4. Since Gupta is usable with a variety of lenses, the Examiner asserts that it would have been obvious utilize the lens of Cohen in the Gupta device for the same reasons that Cohen uses the same.

Response to Arguments

Applicant's arguments filed July 14, 2005 have been fully considered but they are not persuasive.

In response to the argument that the cross-section of Gupta or Portney is not semicircular as claimed, the Examiner asserts that the claimed cross-section can be

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taken along any axis since the axis is not specified. For this reason, when the cross-section is taken perpendicular to the optical axis, the claim language is fully met.

In response to the argument that the prior art devices are not comma shaped, the Examiner asserts that comma shaped is considered a broad term because of the wide variety of shapes attributed to the comma. For this reason, almost any curved surface that does not arc more than about 180° , is considered to be comma shaped.

Conclusion


Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Paul B. Prebilic
Primary Examiner